

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

McLachlan *et al.*

Appl. No.: 10/764,604

Filed: January 27, 2004

For: **Compositions and Methods for
Treating Cancer Using IGSF9 and
LIV-1**

Confirmation No.: 6570

Art Unit: 1642

Examiner: Lei Yao

Atty. Docket: 2159.0030001/EKS/PAC

First Supplemental Information Disclosure Statement

Mail Stop Amendment

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying IDS Forms are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants wish to bring to the Examiner's attention, correspondence that they received dated December 28, 2004 from Andrew Chin, Associate Professor of the School

of Law at the University of North Carolina. The correspondence also included an attachment and a CD ROM.

According to the correspondence, Document NPL3, the CD ROM contains a document entitled "On the Preparation and Utilization of Isolated and Purified Oligonucleotides," that was allegedly produced on March 9, 2002 and contributed to the public collection of the Katherine R. Everett Law Library of the University of North Carolina on March 14, 2002. The correspondence alleges that the CD ROM contains "a full written description of several million oligonucleotides of between 8 and 12 nucleotides in length inclusive, together with the methods of making and using each."

The attachment to the correspondence is alleged to describe the initial portion of the text file stored on the CD ROM. Applicants also submit a single page printout, Document NPL4, from the CD-ROM that appears to generally describe the three files on the CD ROM.

Further submitted is a limited sequence analysis, Document NPL5, conducted by Applicants on the IGSF-9 sequence disclosed in the present application using nucleotide fragments found on the CD ROM. The nucleotides indicated in black failed to align with the oligonucleotides of the CD ROM. The fragments described on the CD ROM are relatively small (8 and 12 mers) and overlap with one another. From 576,344 randomly generated oligos it was found that 3346 individual oligos match some small portion (not more than 12 nucleotides) of the IGSF9 sequence found in the present application. It is believed that approximately 90% of the sequence may be covered due to the overlapping oligos.

This Information Disclosure Statement is being filed before the mailing date of a first Office Action. No statement or fee is required.

Copies of documents FP1-FP10 and NPL1-NPL5 are submitted. However, in accordance with 37 C.F.R. § 1.98(a)(2), no copies of U.S. patents and patent application publications cited on the attached IDS Forms are submitted.

It is respectfully requested that the Examiner initial and return a copy of the enclosed IDS Forms, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Paul A. Calvo
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Date: January 20, 2006

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Institute for form 1449/PTO				<i>Complete if Known</i>	
				Application Number	10/764,604
				Filing Date	January 27, 2004
				First Named Inventor	Karen McLachlan
				Art Unit	1642
				Examiner Name	Lei Yao
Sheet	1	of	1	Attorney Docket Number	2159.0030001/EKS/PAC

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (If Known)			
US1		5693465	12-02-1997	Manning <i>et al.</i>	
US2		2003/0215457 A1	11-20-2003	de Sauvage <i>et al.</i>	
US3					
US4					
US5					
US6					
US7					
US8					
US9					
US10					
US11					
US12					
US13					
US14					
US15					
US16					
US17					
US18					
US19					
US20					

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)			
	FP1	WO 01/55178 A2	08-02-2001	GODDARD <i>et al.</i>	
	FP2	WO 02/16939 A2	02-28-2002	MACK <i>et al.</i>	
	FP3	WO 02/22660 A2	03-21-2002	TANG <i>et al.</i>	
	FP4	WO 02/055705 A2	07-18-2002	MEZES <i>et al.</i>	
	FP5	WO 02/099040 A2	12-12-2002	FRIEDMAN <i>et al.</i>	
	FP6	WO 03/042661 A2	05-22-2003	AFAR <i>et al.</i>	
	FP7	WO 03/051902 A1	06-26-2003	BAUGHN <i>et al.</i>	
	FP8	WO 2004/030615 A2	04-15-2004	WU <i>et al.</i>	
	FP9	WO 2004/073657 A2	09-02-2004	AZIZ <i>et al.</i>	
	FP10	WO 2004/091548 A2	10-28-2004	STROVEL <i>et al.</i>	

467972_1.DOC

Examiner Signature	Date Considered
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹Applicant's unique citation designation number (optional). ²See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Substitute for form 1449/PTO

**FIRST SUPPLEMENTAL
INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**
(Use as many sheets as necessary)

Sheet

1 of 1

Complete if Known

Application Number	10/764,604
Filing Date	January 27, 2004
First Named Inventor	Karen McLachlan
Art Unit	1642
Examiner Name	Lei Yao
Attorney Docket Number	2159.0030001/EKS/PAC

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume issue number(s), publisher, city and/or country where published	T ²
	NPL1	Shi, Song-Hai, <i>et al.</i> , "The immunoglobulin family member dendrite arborization and synapse maturation 1 (Dasm1) controls excitatory synapse maturation," <i>Proc. Natl. Acad. Sci. USA</i> 101:13346-13351, The National Academy of Sciences of the USA (September 2004)	
	NPL2	Shi, Song-Hai, <i>et al.</i> , "Control of dendrite arborization by an Ig family member, dendrite arborization and synapse maturation 1 (Dasm1)," <i>Proc. Natl. Acad. Sci. USA</i> 101:13341-13345, The National Academy of Sciences of the USA (September 2004)	
	NPL3	Letter from Andrew Chin, Associate Professor at The University of North Carolina at Chapel Hill to Dr. Karen McLachlan in regards to U.S. Patent Application No. 10/764,604, 3 pages (December 2004)	
	NPL4	Chin, Andrew, "Table of Contents," for CD ROM (attached herewith), 1 page (March 2002)	
	NPL5	Copy of sequence alignment between Applicants IGSF-9 sequence and the sequence submitted on the CD ROM, 2 pages (performed January 2005)	

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Examiner Signature	Date Considered
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

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